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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/582,296	12/04/2000	Christopher M. Sidebottom	PM 270652	1658

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EXAMINER

TELLER, ROY R

14

ART UNIT PAPER NUMBER

1654

DATE MAILED: 03/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/582,296

Applicant(s)

SIDEBOTTOM ET AL.

Examiner

Roy Teller

Art Unit

1654

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 December 2002.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) 7-9 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

This office action is in response to paper # 13, received 12/2/02, in which:

- 1) Claims 1-6 were amended.
- 2) Claims 7-9 were withdrawn from examination as being directed to a non-elected invention.
- 3) Group II , claim 7 and group III, claims 8-9, were traversed.

The traverse is in the grounds that the close relationship of claims under Groups I, II, and III are based on a common novel feature in the form of using the purified anti-freeze protein and the nucleic acid sequence encoding the anti-freeze protein in a food product. This is not found persuasive because a search of group II or III would not necessarily include the anti-freeze protein of group I. In addition, a search for the invention of group II and III would not be a complete and through search of the pertinent patent and non-patent technical literature. For example, the protein of group I is differently searched and classified from group II and III.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-6 will be examined in this office action.

Claim Rejections - 35 USC § 112

New Grounds of rejection:

Claim 1 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Claim 1 recites "...wherein the modified version of the protein has a covalently attached group which does not affect the ice recrystallization inhibition properties". No support was found in applicant's disclosure for "a covalently attached group" in those portions of the disclosure pointed to in applicant's response. This matter might be resolved if applicant were to more specifically point out where in the disclosure support for this newly added material can be found.

The rejection of claims 1-6 under 35 U.S.C. 112, first paragraph, is maintained. Applicant's arguments have been fully considered but they are not persuasive. Applicant argues that the specification recites glycosylation as an example of a modification, not as the only modification.

Applicant has enabled glycosylated proteins but has not enabled any other modified versions simply by describing the modification as a covalently attached group. On page 4 of Paper No: 13, applicant states "... specification recites glycosylation as an example of a modification, not as the only modification, and one of skill in the art would be able to obtain versions of the protein...". The instant specification has only taught how to make and use a single modification (glycosylated protein) and is not enabled for the full scope of the claims.

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The rejection of claims 1-6 under 35 U.S.C. 112, second paragraph, is maintained.

Applicant's arguments have been fully considered but they are not found persuasive. Applicant argues that the claims as newly amended will overcome the rejection.

Applicant has not set for the metes and bounds of the modifications. The amended claims recite a covalently attached group, but failed to set for the metes and bounds of the claimed groups. For this reason, the metes and bounds of the claimed invention cannot be determined and the claims remain indefinite.

Claim Rejections - 35 USC § 102

The rejection of claims 1 and 2 under 35 U.S.C. 102(b) is withdrawn pursuant to applicant's amendment thereof.

Conclusion

No claims are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Roy Teller whose telephone number is (703) 305-4243. The examiner can normally be reached on Monday-Friday from 5:30 am to 2:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Brenda Brumback, can be reached on (703) 306-3220. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3014.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

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2/24/03
RT


BRENDA BRUMBACK
SUPERVISORY PATENT EXAMINER
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